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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,290	11/17/2005	Rodney Mark Gibson	P1450 USA	8635

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O M (Sam) Zaghmout  
Bio Intellectual Property Service (Bio Ips)  
8509 Kernon Ct  
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EXAMINER
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LAUX, JESSICA L

ART UNIT	PAPER NUMBER
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3635

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08/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,290	<b>Applicant(s)</b> GIBSON, RODNEY MARK	
	<b>Examiner</b> JESSICA LAUX	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 8/03/2009 have been fully considered but they are not persuasive.

In response to applicant's argument that Ciotti does not expressly disclose that “the roof portion and /or the floor portion provide structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of I, in either case without causing structural damage to the building construction...”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim whether the prior art expressly discloses such a use or not. To overcome the reference applicant must provide evidence that the claims provide a structure or distinguishing features that the reference does not have that make applicant's invention capable of the claimed limitation where the prior art is not. Absent such a showing it is determined that Ciotti certainly is capable of the claimed structural integrity just as applicant's invention is. In the instant case applicant has not provided remarks, evidence or facts that demonstrate how the structure of applicant's invention is capable of the claimed “integrity” limitation while the prior art is not.

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In response to applicant's argument that there is no suggestion to combine the references of Ciotti and Abler, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Abler clearly discloses a teaching, suggestion or motivation to include a lock for securing the container during shipping. Additionally it is noted that one of ordinary skill in the art would readily know to lock something against movement during transport as that is not a novel concept. Further, applicant's arguments that the construct of Ciotti is such that it may eliminate the need for a locking mechanism is mere conjecture unsupported by fact. Therefore the totality of evidence, presented by applicant, supporting unobviousness is insufficient to overcome the rejection.

In response to applicant's argument that there is no suggestion to combine the references of Ciotti and WO9802626, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, WO9802626 clearly provides a teaching, suggestion or motivation to include a corner

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protector where such an inclusion provides protection and permits handling of the construct, and additionally the generally known in the art to provide corner protectors for shipping (reference additional US Patent 5761854 , element 26) which clearly demonstrates what is known in the art).

Additionally it is noted that applicant's arguments regarding the Ciotti reference are confusing as first applicant states that Ciotti is not capable of the claimed structural integrity and then (in reference to the WO9802626 document) applicant argues that Ciotti is sufficient capable of the structural integrity to be moved without additional support structure.

Lastly it is noted that the reasoning and rationale supported by the prior art for combining features need not be the same as applicant's reasoning to anticipated the claim.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-2, 5-8, 11-13, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ciotti (20030051417).**

1. Ciotti discloses a building construction having a main portion (generally 10, including 16, 14), a roof portion (25), and a floor portion (24), the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections (as seen in figures 1b-d; paragraphs 0024-0025), the building construction being formed such that the main portion, the roof portion and the floor portion can be arranged with respect to one another such that the building

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construction is substantially in the shape of a box-like freight container in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction, and wherein the building construction can be, after being freighted to a desired site, assembled by swinging the roof portion out from the main portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site (paragraphs 0006, 0023-0025).

2. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures).

5. A building construction according to claim 1, anyone of the preceding claims, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the floor portions can be outside of the respective roof portions when the building construction is in a disassembled state (as seen in the figures).

6. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the building construction is, when in a disassembled state, substantially in the shape of a standard freight container (as seen in the figures; paragraphs 0006, 0023).

7. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures), and wherein the building construction is, when in a disassembled state, substantially in the shape of a standard ISO freight container (paragraph 0023).

8. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures), and wherein the building construction is, when in a disassembled state, substantially in the shape of a standard ISO 40 foot freight container (paragraph 0023).

11. A building construction according to claim 1, including framing and panels wherein the panels can be fitted between parts of the framing to create internal and/or external walls (as seen in the figures; paragraphs 0027-0029).

12. A building construction according to claim 1, wherein the structural integrity is such that the building construction can, when in a disassembled state, be picked up by the crane at or adjacent four corners of the building construction without causing structural damage to the building construction (paragraphs 0006, 0023).

13. A building construction according to claim 1, wherein the building construction is at least partially clad when in a disassembled state (as seen in the figures, clad at least by elements 12, 14).

16. A building construction according to claim 1, wherein the building construction is certified as a shipping container for use on container ships (paragraphs 0004-0005).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciotti (20030051417) in view of Abler (20060185262).**

3. Ciotti discloses the building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures), but is silent regarding locking means for the floor and wall portions such that they can



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each be locked in a substantially vertical orientation when the building construction is in a disassembled state for freighting.

Abler discloses a building construction having hinged wall portions for forming an expanded floor where in a closed position the building is an ISO shipping container, and further discloses that the portions have locking means for freighting (paragraph 0016).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the building of Ciotti to have the locking means as disclosed by Abler to provide a secure container for shipping.

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciotti (20030051417) in view of Morris (5966956).**

4. Ciotti discloses the building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures), but does not disclose that the roof portions can be outside of the respective floor portions when the building construction is in a disassembled state, but instead discloses that they are inside the floor portions.

Morris discloses a building construction have expandable floor and roof portions where when in a non-expanded position resemble a shipping container. Morris further discloses that the roof portions can be outside the respective floor portions when the building construction is in a disassembled state (figure 3).

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At the time the invention was made it would have been obvious to one of ordinary skill in the art to pursue known techniques of sidewall placement (such as that disclosed by Morris) and employ them to achieve the predictable results of a floor and roof portions that expand. Further it is noted that whether the roof portions are above or under the floor portions in the disassembled state appears to be a mere matter of obvious design choice as applicant has not disclosed that either position provides an advantage, or solves a stated problem, but rather discloses either embodiment to be acceptable. As the prior art clearly discloses either position to be known it would have been obvious to pick one for applicant's own invention.

**Claims 9-10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciotti (20030051417) in view of WO9802626.**

9-10, 12. Ciotti discloses the building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures),

But does not disclose a removable corner protector arranged over at least part of an external edge or along a different external edge of the disassembled construction to provide a measure of protection and/or strength to the construction when it is being transported.

WO9802626 discloses foldable, portable building construction comprising removable corner protector 26 to aid in moving the building when being transported (as seen in figure 16).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the building construction of Ciotti do include the corner protectors of WO9802626 to aid in safely and efficiently transporting the construction, such that the building construction can, when in a disassembled state, be picked up by the crane at or adjacent four corners of the building construction without causing structural damage to the building construction.

***Allowable Subject Matter***

Claims 14,17,18 are allowed.

***Conclusion***

This is an RCE of applicant's earlier application. All claims are drawn to the same invention claimed in the earlier application and could have been, and in fact were, finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/J. L./  
Examiner, Art Unit 3635